UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,642	10/11/2001	Jonathan M. Cohen	112163.124 U	1956

7590 01/18/2005

Hale & Dorr
1455 Pennsylvania Avenue N W
Washington, DC 20004-1008

EXAMINER	
YANG, NELSON C	
ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/856,642	COHEN, JONATHAN M.	
	Examiner	Art Unit	
	Nelson Yang	1641	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *18 November 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *See Continuation Sheet*.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *of the reasons stated in the prior action*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *3,5-8,11,12 and 14-23*.

Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). *4/30/04*.

10.☐ Other: _____

LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
12/26/04

Continuation of 2. NOTE: the limitation of producing by a multi-step staining process does not clearly delineate what is performed, or what sort of staining process is performed, and therefore could encompass the techniques taught by Kononen et al and Kalra et al. It should also be noted that limitations in the preamble to not carry patentable weight, therefore limitations such as performing in situ hybridization and performing immunohistochemistry in the preamble do not have any patentable weight, and have not been considered. Applicant has further addressed the issue of the high throughput manner. As was pointed out by applicant, high-throughput manner refers to the "capability" to treat more than 20,000 tissue samples in one day (pg. 8), not necessarily that 20,000 tissue samples are actually treated. In the application, the high throughput manner appears to be performed by one or two runs of twenty slides or microarrays, each supporting up to 1000 tissue samples - but this is not necessarily the only technique that would fulfill the definition of high-throughput. Applicant may also wish to further consider the following prior art: Copeland et al [US 5,595,707] teaches an automated immunostaining apparatus that can perform any standard immunochemical assay more rapidly, reliably and with more reproducible results than standard methods (column 2, lines 30-50), Richards et al [US 6,296,890], who teaches an apparatus and methods for automatically staining or treating multiple tissue samples mounted on microscope slides so that each sample can receive an individualized staining or treatment protocol (column 3, lines 28-40).